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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,170	07/20/2001	Howard Taitel	04899-058001	1865
959	7590	10/11/2006	EXAMINER	
LAHIVE & COCKFIELD 28 STATE STREET BOSTON, MA 02109			COBY, FRANTZ	
			ART UNIT	PAPER NUMBER
			2161	

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/910,170

Applicant(s)

TAITEL, HOWARD

Examiner

Frantz Coby

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 07-27 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

This is in response to Applicant's Pre-Appeal brief request for review filed on July 27, 2006.

Response to Arguments

A Pre-Appeal conference was held on September 26, 2006. It was decided that the claims can be better rejected under 37 U.S. C. 103(a) in light of the Suguta reference U.S. Patent no. 6,901,579. Prosecution is hereby re-opened.

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

A new ground of rejection is set forth below:

After further search and reconsideration of the present Application, the Examiner has found new reference U.S. Patent no. 6,901,579 issued to Suguta that reads on the claims (Claims 1-42). In view of the newly found reference, the indication of allowable subject matter is withdrawn and a new ground of rejection is set forth below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-9, 36-37 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1, 8, 9, recite the limitation "generating code that is capable of real-time execution based on the critical portions of the model"; however, silent as to what is realized when the identified portion is non-critical. This recitation and omission in the claims render them indefinite since when the computer method identifies portions that are non-critical for the identifying step, the step of generating code is not realized, leading to no transformation. What is left in the claims, in that case scenario is the step of "identifying portions of a model as being non-critical to a real-time execution of the model" which becomes a single step claim that renders claims 1, 8 and 9 vague and indefinite.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16, 18-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth

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rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

As per 16, claim 16 recite a single means, such as a graphical user interface" to receive user inputs. This single means render the claim indefinite.

In particular, claim 16 recites, "A system comprising a graphical interface (GUI) adapted to receive user inputs to specify components of a model". So far the claim is simply providing a GUI, which is a means for receiving user inputs. Although the claim states that the components containing a first subset and second subset of sections, these differences are only found in the nonfunctional descriptive material and do not alter how the GUI is adapted to receive user inputs to specify components of a model. In other words, the descriptive material does reconfigure the GUI to receive user inputs. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, See In re Gullack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ 1031 (Fed. Cir. 1994).

As per claims 18-23, these claims are at least rejected for their dependencies on the rejected claim 16 above. They are therefore rejected as set forth above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-16, 18-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suguta U.S. Patent no. 6,901,579.

As per claims 1, 8 and 9, Suguta discloses a computer implemented method and program including processor for identifying portions of model by providing an automatic

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object-oriented programming language program generation apparatus for automatically developing part of a program for improving productivity in developing the program using an object-oriented programming language, an automatic generation method of the program, and a storage medium for storing the method of the program (See Suguta Col. 1, lines 11-17). In particular, Suguta discloses the claimed limitations of "generating code" is capable of real-time execution and it is realized as automatic generation of a copy constructor in an object-oriented programming language program which enables duplication of an object. Conventionally, such a program as shown in FIG. 2C must be made by a user, Since Suguta allows automatic generation of source codes, generation of codes that is capable of real-time execution is realized (See Suguta Col. 2, lines 40-51).

Although Suguta discloses generation of source codes including *means for indicating the role of the class in the generated source code* (See Suguta Title); it is noted, however, Suguta did not specifically detail the aspects of model that are critical or non critical to a real time execution as recited in the instant claims. However, One of ordinary skill in the art would have found it obvious, at the time of the invention, in the source code generation system of Suguta, that aspects that are critical or non critical is realized because when the system of Suguta is generating a source code, functions (although being part of the overall software) that are important to realized the source code generation are activated and functions (although being part of the overall software) that are not necessary for the generation of the source is not called or activated. In general, when a computer application or a computer operating system is

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being initiated, the modules that are necessary for the initiation of the software program is called; whereas, modules that are not needed for the computer program to initiate are not called. Further, the means for indicating the role of the class in the generated source code (*See Suguta Title*) disclose by Suguta is an indication that Suguta realized that it is important for its system to understand the role of each module in the overall source code generated so that each module can be called for its proper or appropriate role during execution of the source code. Therefore, the claimed feature of generating source code and identifying portions that are critical or non-critical can also be realized during execution of the source code of Suguta since the determination of what is critical or non-critical to achieve execution of the generated source code is necessary and will be achieved in the background during execution of the generated source code.

As per claims 2-7, most of the limitations of these claims have been note in the rejection of claims 1,8 and 9 above. They are at least rejected for their dependencies, directly or indirectly, on claims 1, 8 and 9.

As per claims 10-15, most of the limitations of these claims have been note in the rejection of claims 1,8 and 9 above especially, the aspect of "generating software code". In addition, Suguta discloses the claimed feature of "a code generator" through a program generation unit (*See Suguta Figure 3, component 5; Col. 5,lines 9-67*), A GUI; post processing unit sections; linking codes through inter-process communication links;

applying software to generate codes and receiving output from the code via inter process link (See Suguta Figure 3; Col. 6, lines 30-38)

As per claims 16, 18-23, most of the limitations of these claims have been noted in the rejection of claims 1, 8, 9 and 10-15 above especially, the aspect of "automatic generation of software code". In addition, Suguta discloses "a system comprising a graphical user interface (GUI) adapted to receive user inputs to specify components of a model, the components containing a first subset of sections designated as post-processing elements of a model and second subset of sections designated as core elements of the model" (See Suguta Figure 4; Col. 6, lines 30-56); "essential computer components (See Suguta Figure 4 and corresponding text); high level computer programming as C++ including compiler (See Suguta Col. 6, line 56-Col. 7, line 31).

As per claims 24-29, all the limitations of these claims have been noted in the rejection of claims 1-23 above. They are therefore rejected as set forth above.

As per claims 30-33, Suguta discloses "a processor and a memory configured to specify block diagram model" (See Suguta Title, Abstract), the block diagram model including data having internal pre-defined data storage classes and external custom data storage classes (See Suguta Figures 3-7 and corresponding text); and Suguta discloses the claimed limitations of "generate software source code for the block diagram model with a code generator using the internal predefined data storage classes

and the external custom data storage classes” by providing methodology for generation of source code from classes (See Suguta Col. 2, line 40-Col. 3, line 19).

As per claims 31-33, most of the limitations of these claims have been noted in the rejection of claim 30 above. In addition, Suguta provides computer system that incorporates processor and memory that is usable as a personal computer, single computer and can as well be connected into a computer network (See Suguta Figure 4 and corresponding text).

As per claims 34-42, all the limitations of these claims have been noted in the rejection of claims 1-33. They are therefore rejected as set forth above.

Claim 16 recite “a system comprising a graphical interface (GUI) adapted to receive user inputs to specify components of a model”. So far the claim is simply providing a GUI, which is a means for receiving user inputs. Although the claim states that “the components containing a first subset and second subset of sections, these differences are only found in the nonfunctional descriptive material and do not alter how the GUI is adapted to receive user inputs to specify components of a model. In other words, the descriptive material does reconfigure the GUI to receive user inputs. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, See *In re Gullack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ 1031 (Fed. Cir. 1994).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz Coby whose telephone number is 571 272 4017. The examiner can normally be reached on Monday-Friday 9:00AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 571 272 4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


FRANTZCOBY
PRIMARY EXAMINER

September 29, 2006